

REMARKS

At the outset, the Examiner is thanked for the thorough review and consideration of the present application.

The Examiner's non-final Office Action dated July 17, 2001 has been received and its contents carefully noted. Claims 1-18 were pending in the present application. By this Amendment, new claims 19-77 have been added to recite the detailed potential relationship between each element. No new matter has been introduced by this Amendment. Accordingly, claims 1, 10, 19, 29, 39, 49, 58 and 68 are the pending independent claims.

Claim Rejections - 35 U.S.C. § 103(a)

Claims 1-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Adler et al., U.S. Patent No. 4,766,424 (Adler), in view of Parks, U.S. Patent No. 4,963,859 (Parks).

It should be noted that three criteria must be met to establish a *prima facie* case of obviousness. *M.P.E.P. § 2143*. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings to achieve the claimed invention. *Id.* Second, there must be a reasonable expectation of success. *In re Rhinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976). Third, the prior art must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

The Applicants respectfully contend that the Examiner has failed to set forth a *prima facie* case of obviousness. There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Adler or Parks or to combine reference teachings to achieve the claimed invention. The Examiner has simply attempted to identify some of the features of Adler that are similar to the present invention and points to Parks to fill in the holes of the Adler reference. The Examiner concedes that Adler does not teach or disclose "illumination means for illuminating an incident light face of the lens sheet" (p. 2, Paper No. 6). The Examiner cites Parks to teach this feature. The Examiner alleges in the rejection that the combination would be made in order "to provide a

method of writing or drawing on a surface which is supported by transparent material " (p. 3, Paper No. 6); however, the Examiner gives no explanation or teaching from any of the references to indicate that one with ordinary skill in the art at the time of the invention would have had motivation to combine the references in order to create the present invention.

Even assuming motivation could be found, the Examiner has not given any indication that one with ordinary skill in the art at the time of the invention would have had a reasonable expectation of success when combining Adler and Parks.

Furthermore, the prior art does not teach or suggest all the claim limitations. In the rejection, the Examiner contends that Adler discloses a touch panel comprising a light guide panel, an optical sensor array, and a lens sheet. The present invention discloses a lens sheet having a light emitting face thereof opposed to a first side face of a light guide panel (e.g. spec. page 8, lines 1-21, Fig. 1). This claimed structure indicates that the lens sheet is provided as to be separated from the light guide panel. Although the Examiner is contending that Adler discloses the lens sheet of the present invention, it appears that lens 72 of Adler constitutes a part of a light guide itself 70 (Fig. 5), and it is clearly different from the lens sheet of the present invention. Parks does not correct the deficiencies in Adler. As noted above, the Examiner cites Parks in order to teach an illumination means. Neither Adler, nor Adler in view of Parks teaches or suggests a display device comprising a light guide panel and a lens sheet, as claimed, as separate components of the display device.

In addition, with respect to claim 10, a touch panel of the present invention is provided over a display screen of a display device. Neither Adler nor Parks disclose or suggest a touch panel over a display screen of a display device. Therefore, the cited prior art references do not teach or suggest all the claim limitations and the rejection under § 103 should be withdrawn.

The Applicants further contend that even assuming, *arguendo*, that the combination of Adler and Parks is proper, there is a lack of suggestion as to why a skilled artisan would use the proposed modifications to achieve the unobvious advantages first recognized by the Applicants. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990).

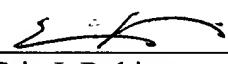
Therefore, Applicants respectfully request that the Examiner withdraw the § 103 rejections.

New claims 19-77 recite detailed potential relationship between each element.

Conclusion

Prompt and favorable consideration is requested. In view of the above, all the claims in this case are believed to be in condition for allowance. Should the Examiner deem that any further action by the Applicant would be desirable in placing this application in even better condition for issue, the Examiner is requested to contact the undersigned.

Respectfully submitted,


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